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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/777,192 | 02/13/2004 | Takenobu Kobayashi | 00684.003585. | 7532 |
| 5514 7590 11/26/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | | |
| EXAMINER | | | | |
| SETH, MANAV | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2624 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 11/26/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/777,192

Applicant(s)

KOBAYASHI ET AL.

Examiner

MANAV SETH

Art Unit

2624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,8 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment after final

1. Applicant's amendment filed on October 23, 2008 has been considered and entered in full.
2. Applicant's arguments with respect to claims have been considered and are persuasive, therefore all prior art rejections on the claims have been withdrawn and the finality of the previous office action has been withdrawn. However, claims 1-2 and 4-6 are further subject to 35 USC 101 rejections and claims 13 and 15 are subject to 35 USC 112 rejections.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)) indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, claim 1 recites steps such as

scanning step, calculating step and a correcting step, these steps do not positively tie to a statutory category and could merely be interpreted as an abstract idea. Examiner suggests amending the claims by inserting a statutory category for steps in the body of the claim on which the method steps are performed. Claims 2, 4-6 depend on claim 1, therefore they are rejected for the same reason as claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the remarks filed with amendment filed on 10/23/2008, applicant discloses that only claims 1 and 7 are independent.

Claim 13 which depends on claim 7 recites the limitation “an exposure apparatus for scanning an object in”. There is insufficient antecedent basis for this limitation in the claim. Claim 7 does not recite “exposure apparatus”.

Claim 15 which depends on claim 13 recites the limitation “a method of manufacturing a device”. There is insufficient antecedent basis for this limitation in the claim. Claim 13 does not recite “method of manufacturing a device”.

Allowable Subject Matter

Reasons of Allowance:

7. Claims 7-8 and 10-12 are allowed.

The following is an examiner's statement of reasons of allowance:

Both the instant invention and the closest prior art Yamada et al., U.S. Patent 6,081,614, are directed to a method and system of measuring a position of a surface of an object while the object is scanned relative to a detection unit in a scanning direction in an X-Y plane, the detection unit being configured to detect the position of the surface in the Z direction perpendicular to the X-Y plane (See Yamada – Abstract and col. 7, lines 12-30, 55-62). The instant invention further recites “scanning the object relative to the detection unit in two scanning directions opposite to each other, further detecting a position of the surface in the Z direction for the same detection point on the surface with respect to each of the two scanning directions and then calculating a correction value for correcting a position of the surface to be detected based on the positions of the surface detected in the two scanning directions” in claim 7 which is not taught by the closest prior art of record.. Therefore claim 7 is allowed. Other claims (8 and 10-12) depending on claim 7 would be allowable at least by dependency on claim 7.

Claim 1 and the claims depending on claim 1 would be allowable for the same reason as applied to claim 7, after all the rejection issues have been resolved

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manav Seth whose telephone number is (571) 272-7456. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Bella, can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Manav Seth/
Art Unit 2624
November 24, 2008